

REMARKS

In the last Office Action, the Examiner rejected claim 26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,504,677; claims 1-80 of U.S. Patent No. 5,727,249; and claims 1-80 of U.S. Patent No. 6,041,315. Claim 26 is also rejected under 35 U.S.C. § 102(b) as being based upon a public use or sale of the invention based on the article by Lisa Fickenscher entitled "Autoscribe Wins Patent for Phone Payment System," (hereinafter Fickenscher).

By this Amendment, Applicant adds new claims 27-50 to afford the full scope of protection to which he is entitled. Applicant includes with this response a Terminal Disclaimer and a Supplemental Declaration, as well as brochures and marketing materials which were requested in the last Office Action. Applicant respectfully requests reconsideration for the following reasons.

Rejections based on Double Patenting

In the last Office Action, claim 26 was rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of related U.S. Patent No. 5,504,677; claims 1-80 of related U.S. Patent No. 5,727,249; and claims 1-80 of related U.S. Patent No. 6,041,315. Applicant notes that the instant application has been assigned to Autoscribe, Inc., owner of the related patents. Applicant includes a terminal disclaimer with this response in accordance with 37 C.F.R. § 1.321(c). For at least this reason, the rejection of claim 26 should be withdrawn. Accordingly, Applicant respectfully deems the rejection overcome.

Rejections under 35 U.S.C. § 102(b)

In the last Office Action, claim 26 was rejected under 35 U.S.C. § 102(b) in view of the Fickenscher article, based upon an allegation made by the Examiner of public use or sale of the invention. Applicant disagrees with the rejection alleging public use or sale of the claimed invention more than one year prior to the date of October 15, 1992, which is the filing date of patent application Serial No. 08/959,930, now U.S. Patent No. 5,505,677, from which the present application claims benefit of priority under 35 U.S.C. § 120.

Applicant submits herewith a declaration under 37 CFR § 1.132 by the Inventor to the effect that the Autopay service mentioned was not:

An automated system for generating authorized drafts on a plurality of financial accounts belonging to a plurality of payors, in payment of debts to a payee, comprising:

input means for performing an electronic information input process in which input information is received, including a manual input of account identification information sufficient to identify a particular one of said payor financial accounts and a financial institution holding said account, and amount information defining an amount to be paid to said payee;

processing means connected to said input means for receiving said input information and processing said information to format a draft on said financial account payable to said payee, said draft format including identification of said financial account, identification of said financial institution holding said financial account, and an instruction to pay said amount to said payee including particular identification of said payee, and further including a signatory block for an authorizing signature other than said payor's signature;

output means for transferring said draft format to an external magnetic printing means connectable to said processing means for generating a paper copy of said draft using magnetically encoded ink and printing fonts compatible with clearing house check processing equipment.

Therefore, the rejection of claim 26 under 35 U.S.C. § 102(b) based on alleged public use or sale of the invention is respectfully deemed overcome.

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In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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